

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Rodolfo VASONE) Confirmation No. 7818
Application No.: 10/568,199) Group Art Unit: 2175
Filed: February 10, 2006) Examiner: Thanh T. VU
For: COMPUTER ORIENTED WAY)
DEVICE BY THREE-)
DIMENSIONAL IMAGE)

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal filed July 5, 2011 has initiated an appeal process relative to the rejections of Claims 1-13. Submitted herewith are an Appeal Brief and the requisite fees set forth in 37 C.F.R. § 41.20(b) in order to continue the appeal process.

I. REAL PARTY IN INTEREST

The real party in interest is Rodolfo Vasone, the Inventor of this application.

II. RELATED APPEALS AND INTERFERENCES

To the best knowledge of the undersigned, Appellant, and Appellant's legal representative there are no prior or pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by, or have a bearing on, the Board's decision in this appeal.

III. STATUS OF THE CLAIMS

Claims 1-13 have been rejected more than two times and are on appeal.

IV. STATUS OF THE AMENDMENTS

No Amendments have been submitted in this application subsequent to the Notice of Appeal filed on July 5, 2011.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

a. Independent Claims 1 and 6

Independent Claim 1 is directed to a computer-based device configured to generate a three-dimensional image so as to facilitate the localization of a user within a place of interest (see, page 1, ¶ [0001] of the publication of this patent application), the place of interest being selected from the group comprising departments, stores, items in exposition, numbered seats and strategic points of great shopping centers, museums, big stores, supermarkets, companies, houses of entertainment, theaters, fairs, and events as recited in the originally filed Claim 1. As originally recited, said computer-

based device comprises an electronic equipment with a monitor and a device for controlling movement of an icon on a display screen having an instantaneous menu of search (*Id.*, ¶ [0015]); and a computer program that searches the place of interest so that, when the user identifies a desired destination, the computer program generates a three-dimensional image showing a shortest and best route to be followed by the user from a point at which the user identifies the desired destination to the desired destination ***the shortest and best route to be covered by means of an object in movement*** (*Id.*, ¶ [0016], emphasis added).

Similarly, independent Claim 6 is directed to a device that generates and displays a three-dimensional simulation path from a first point to a second point within a place of interest selected by a user, the device comprising: a monitor with a display screen; a device for controlling movement of an icon in the display screen; and a computer readable medium including computer executable instructions, wherein the instructions, when executed, implement a method for generating and displaying the three-dimensional simulation path from the first point to the second point within the place of interest selected by the user, the method comprising: selecting the place of interest from a search menu in the display screen; identifying the first and second points within the place of interest; generating the three-dimensional simulation path from the first point to the second point; and displaying the three-dimensional simulation path on the display screen with an object in movement.

b. Dependent Claims 2, 3, 7, and 10

Claims 2-5 and 7-13 depend directly or indirectly from Claim 1 and Claim 6,

respectively, and inherit patentable distinguishing features from those respective claims besides reciting additional patentable distinguishing features.

For example, Claims 2 and 7 each specify execution in real time, illustrating instantaneously where products, places or items looked for by the user are situated (*Id.*, ¶ [0017]).

In addition, Claims 3 and 10 each specifies the display of promotions that use audiovisual resources, as a way to call the attention of customers and visitors of a place where the electronic equipment containing the program is installed (*Id.*, ¶ [0019]).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A number of grounds of rejection are raised by the Examiner in the outstanding Final Office Action, as follows:

1. The rejection of Claims 1-13 under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement;
2. The rejection of Claims 1-13 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention; and
3. The rejection of Claims 1-13 under 35 U.S.C. §102(e) as allegedly being anticipated by Kida (Patent Application Publication US 2006/0092155, hereinafter "Kida").

Appellant respectfully requests review of all these rejections based on the following discussion.

VII. ARGUMENTS

a. The Examiner has not carried its burden for establishing a *prima facie* case for failure of Claims 1-13 to comply with the written description requirement under 35 U.S.C. § 112, first paragraph

In *Hyatt v. Dudas*, (492 F.3d 1365, 1370, 83 USPQ2d 1373, 1376 (Fed. Cir. 2007)), the CAFC held that “[MPEP] § 2163.04 (I)(B) as written is a lawful formulation of the *prima facie* standard for a lack of written description rejection.” In addition, it is well established that the “examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims” (MPEP 2163(II)). Once USPTO personnel have advanced a reasonable basis for questioning the adequacy of the disclosure, it becomes incumbent on the applicant to rebut that challenge and factually demonstrate that his or her application disclosure is in fact sufficient (See *In re Doyle*, 482 F.2d 1385, 1392, 179 USPQ 227, 232 (CCPA 1973); and *In re Scarbrough*, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974). See also MPEP § 2106, paragraph V.B.2 and § 2164 - § 2164.08(c).) Finally, “***there is a strong presumption*** that an adequate written description of the claimed invention is present in the specification as filed” (see, for example, *Wertheim*, 541 F.2d at 262, 191 USPQ at 96, emphasis added).

As clearly stated in MPEP § 2163.04 (I)(B) (emphasis added), in rejecting a claim for failure to comply with the written description requirement, ***the examiner must set forth express findings of fact which support his conclusion***. These findings should: (A) identifying the claim limitation at issue; and (B) ***establishing a prima facie case by***

providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.

Appellant respectfully submits that in the four Office Actions issued in this application (i.e., Office Actions mailed on March 10, 2009, June 12, 2009 (final), November 5, 2010, and April 6, 2011 (final)), no reasonable basis to challenge the adequacy of the written description has been provided based on **any evidence**, let alone on a preponderance of evidence, why a person skilled in the art would not recognize in applicant's disclosure a description of the invention defined by the claims. As such, since a description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut that presumption, the Examiner has not carried its burden for establishing a *prima facie* case for failure to comply with the written description requirement under 35 U.S.C. § 112, first paragraph.

Regrettably, in response to repeated requests from Appellant for the Examiner to follow the above-summarized procedures, no evidence has been provided and the only response has been a request for Appellant to specifically point out where originally filed claimed expressions find support in the specification. (See, for example, the Office Action mailed on Nov 5, 2010 as well as the Outstanding Office Action, pages 2 and 3). Appellant respectfully submits that, in addition to the lack of adherence to the above-summarized requirements, such a repeated request disregards (1) Appellant's response filed on Feb 7, 2011, where specific support for the requested terms have been shown in relation to the originally filed claims and (2) the fact that there is no *in haec verba*

requirement in order to show support for the written requirement (see, for example, MPEP 2163(I)(B)).

In response to the detailed showing of where support of several claim elements is found in the originally filed claims (see pages 8 and 9 of the response filed on Feb 7, 2011), the Examiner commented that: (1) “[t]he examiner does not agree that each and every element of the amended claim are supported by the original claims” and (2) “the original claims are full of 35 U.S.C. 112, first paragraph and second paragraph rejections as described the non-final action dated 03/10/2010” (Outstanding Office Action, page 3, lines 12 and 13 and page 5, lines 11-13). Appellant respectfully submits that such a disagreement is problematic for at least two reasons. First, it is a statement of conclusion without any explanation or substantiation based on any evidence. And, secondly, it disregards and does not consider detailed explanation submitted to the Office by Appellant, thus preventing Appellant from advancing the prosecution of this application.

Finally, noting that the “written description requirement is separate and distinct from the enablement requirement” (see, for example, *In re Barker*, 559 F.2d 588, 194 USPQ 470 (CCPA 1977), cert. denied, 434 U.S. 1064 (1978) and *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991)), the statement that “the specification provides no examples or explanations of the instant application from start to finish instructing one skill in the art of how to construct the instant application *without undue experimentation*” (see, Outstanding Office Action, page 2, lines 14-16, emphasis added) is unclear and in disregard of the well-known difference between the written-description and enablement requirements.

Therefore, based at least on the above-summarized arguments, Appellant respectfully requests that the Board reverses the outstanding rejection of Claims 1-13 for failure to comply with the written requirement under 35 U.S.C. § 112, first paragraph.

b. Claims 1-13 are definite and The Examiner erred in the rejection of Claims 1-13 under 35 U.S.C. § 112, second paragraph

As to the rejection of Claims 1-13 under 37 U.S.C. §112, second paragraph, Appellant respectfully submits that reading of Claims 1 and 6, together with and supported by the disclosure of the present application, is sufficient to particularly point out and distinctly claim the subject matter of the instant invention being claimed therein.

As to Claim 1, the outstanding Office Action asserts that (1) "Claim 1 recites an electronic equipment having a monitor and a device for controlling movement of an icon of a display screen that possesses an instantaneous menu of search. It is unclear of what possesses an instantaneous menu of search" (Outstanding Office Action, page 6, lines 4-6); and (2) "Claim 1 recites a three dimensional image showing the shortest and best route to be followed by the user from a point at which the user identifies the desired destination to the desired destination. It is unclear how the user indentifies the desired destination to the desires destination" (*Id.*, lines 7-10).

As to the question of "what possesses an instantaneous menu of search" in Claim 1, Appellant respectfully submits that it is the "display screen." That is so for at least two reasons. First, those of ordinary skill in the art understand that monitors have display screens in which information, such as a menu of search, may be normally presented to users. And secondly, based on the grammatical construction of this

portion of Claim 1, it is clear that the relative pronoun "that" next to the expression "display screen" connects that same term to the restrictive relative clause of "possesses an instantaneous menu of search."

As to the question that it is unclear "how the user identifies the desired destination to the desired destination" in Claim 1, Appellant respectfully submits that, despite the obscurity of this statement, any route comprises at least two points ~ a starting or first point and an ending or second point. As such, the shortest and best route to be followed by the user is from a first or starting point to a second or ending point, i.e., as claimed, from "a point the user identifies the desired destination" (the first or starting point) to "desired destination" (the second or ending point). Thus, based at least on the above-summarized explanations, Claim 1 as written is sufficient to particularly point out and distinctly claim the subject matter of the instant invention being claimed therein.

As to Claim 6, the outstanding Office Action asserts that (1) "Claim 6 recites the three-dimensional simulation path from the first point to the second point within the place of interest selected by the user. It is unclear how a simulation path from the first point to the second point is within the place of interest selected by the user" (*Id.*, lines 11-13); and (2) "Claim 6 recites the limitation "the place." There is insufficient antecedent basis for this limitation in the claim" (*Id.*, lines 14 and 15).

As to the question that it is "unclear how a simulation path from the first point to the second point is within the place of interest selected by the user," Appellant respectfully notes that the device recited in Claim 6 is configured to generate and display a three-dimensional simulation path from a first point to a second point within a

place of interest selected by a user. Once the place of interest is identified, the shortest and best route from the first point (the point from which the user is requesting assistance from the system for direction) to the second point (the desired destination) is calculated and displayed to the user.

Finally, as to the lack of antecedent basis for the expression "the place," the amendment filed last February has corrected that informality, but such amendment appears to have been disregarded by the Office in repeating that rejection of Claim 6. Thus, based at least on the above-summarized explanations, Claim 6 as written is sufficient to particularly point out and distinctly claim the subject matter of the instant invention being claimed therein.

Therefore, based at least on the above-summarized arguments, Appellant respectfully requests that the Board reverses the outstanding rejection of Claims 1-13 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention under 35 U.S.C. § 112, second paragraph.

c. Kida fails to anticipate the feature of (1) "the shortest and best route to be covered by means of an object in movement" and (2) "displaying a three-dimensional simulation path on a display screen with an object in movement" as recited in Claims 1 and 6, respectively and other features recited in the dependent claims

Appellant respectfully submits that Claims 1 and 6 are not anticipated by Kida because each and every element as set forth in that claim is not found, either

expressly or inherently described, in the cited reference. In an anticipation rejection, the identical invention must be shown in as complete detail as is contained in the claim.¹

Kida discloses a position related information presentation system "that allows a user to experience as if *the user had actually walked round* and collected information about an area." (Kida, abstract, emphasis added.) A 3D map/information superimposed displaying portion reads 3D map data from a 3D map storing portion and displays area information related to the area displayed on the 3D map superimposed on the 3D map to the user. When the user changes a display of the 3D map by using a display change inputting portion, a position information searching portion searches for information related to a new display position from an area information storing portion. A field of view determining portion detects superimposing of one object on another such as buildings when viewed from the current position of the user using the map of the map database. A position information filtering portion searches for information related to objects visible to the user from the searched area information. (*Id.*)

As illustrated in FIGS. 1, 14, 23, and 26 of Kida, four exemplary embodiments of the disclosed position related information presentation system are provided. For example, in FIG. 1, the position related information presentation system according to the first embodiment of the present invention is constructed of display change inputting portion 1, 3D (3 Dimensions) map/information superimposed displaying portion 2, 3D map storing portion 3, position information filtering portion 4, field of view determining

¹ See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also

portion 5, a map database (DB) 6, position information searching portion 7 and position information storing portion 8 (*Id.*, ¶ [0085]).

Five embodiments of a display screen were illustrated, as clearly shown in FIGS. 2, 16, 24, 32, 33, and 38, which embodiments basically comprise a 3D map display area 201, a user operation input area 202, and an area information link display area 203 (*Id.*, ¶ [0093]).

In the user operation input area 202, the user makes entries to change the display of the 3D map display area 201 by entering "Forward", "Back", "Left" and "Right" in the area 20201, and the content of the 3D map displayed in the 3D map display area 201 and the content of the area information related to the 3D map displayed in the area information link display area 203 are changed according to the respective entries (*Id.*, ¶ [0097]).

According to a feature of the invention as set forth in Claims 1 and 6, a three-dimensional image is recited showing the shortest and best route by means of an object in movement. Kida does not expressly or inherently describe such an advantageous feature; therefore it cannot anticipate Claims 1 and 6.

In its rejection of Claims 1 and 6, the Office states that FIGS. 9, 32, and 38 and paragraphs [0140], [0210], [0211], and [0219] of Kida anticipates the noted subject matter of Claims 1 and 6. In particular, in the rejection of Claim 6, the Examiner states that "figs. 9, 32, and 38; [0140], [0210], [0211], and [0219]; which shows arrows indicating a direction of travel (i.e. notes) of a user movement; fig. 38 with notes 20301

and 20302." Appellant respectfully disagrees and submits that an element-by-element indication to substantiate such a conclusory statement has not been provided. Neither an arrow nor a user movement can reasonably be said to anticipate the claimed subject matter of an object in movement. Kida is absolutely silent as to any movement of the disclosed arrows and a user is not an object, assuming *in arguendo* that Kida discloses that the user moves. Consider as an example, but not as a limitation to Appellant's ability to argue such an unsubstantiated conclusion, that in none of the listed paragraphs of Kida one finds any disclosure expressly or inherently describing the generation of a three-dimensional image showing the shortest and best route by means of an object in movement.

Among other features, in the cited paragraphs of Kida arrows indicating the direction of travel are disclosed. As further explained in paragraph [0210] of Kida "the 3D map/information superimposed displaying portion 2 displays the path which the user should currently follow (step S69 in FIG. 27) (see FIG. 32). In FIG. 32, an arrow 20103 in the center of the screen indicates the direction that the user should follow." Applicant respectfully submits that an arrow indicating a direction of travel of a user movement is not (expressly or inherently) the recited feature of an object in movement.

Applicant respectfully submits that Claims 1 and 6 are not anticipated by Kida. This cited prior art reference does not disclose expressly or inherently the generation of a three-dimensional image as recited in these claims. Claims 2-5 and 7-13 should be allowed, among other reasons, as depending either directly or indirectly from Claims 1 and 6, respectively, which should be allowed as just explained.

In addition, Claims 2-5 and 7-13 are further considered allowable as they recite other features of the invention that are not disclosed, taught, or suggested by the applied reference when those features are considered within the context of the subject matter recited in independent Claims 1 and 6. For example, Claims 2 and 7 each specify execution in real time, illustrating instantaneously where products, places or items looked for by the user are situated. Also, Claims 3 and 10 each specifies the display of promotions that use audiovisual resources, as a way to call the attention of customers and visitors of a place where the electronic equipment containing the program is installed. As to Claims 2 and 7, contrary to what has been asserted by the Office, Kida is silent to any execution in real time in paragraphs [0034], [0043], [0113], and [0210]. Also, as to Claims 3 and 10, contrary to what has been asserted by the Office, Kida is silent with respect to any use of audiovisual resources in paragraphs [0098] and [0211] or elsewhere. Similar arguments can be presented to the rejection of Claims 2, 4, 5 and 7-9, and 11-13. Therefore, Applicant respectfully requests that the anticipation of Claims 1-13 under 35 U.S.C. §102(e) be reverse by the Board.

VIII. CONCLUSION

Appellant respectfully submits that Claims 1-13 comply with the written description requirement and are definite taking into consideration the requirements of 35 U.S.C. § 112, first and second paragraphs. In addition, Claims 1-13 are not anticipated by Kida. As such, reversal of all the Examiner's rejections is respectfully requested.

Respectfully submitted,

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IX. CLAIM APPENDIX

1. A computer-based device configured to generate a three-dimensional image for facilitating a localization within a place of interest selected from the group comprising departments, stores, items in exposition, numbered seats and strategic points of great shopping centers, museums, big stores, supermarkets, companies, houses of entertainment, theaters, fairs, and events, the device comprising:

an electronic equipment having a monitor and a device for controlling movement of an icon of a display screen that possesses an instantaneous menu of search; and a computer program installed in the electronic equipment, wherein the computer program searches the place of interest of a user, in different categories of search, so that, when the user identifies a desired destination, the computer program generates a three-dimensional image showing a shortest and best route to be followed by the user from a point at which the user identifies the desired destination to the desired destination, along with notes about the shortest and best route to be covered by means of an object in movement.

2. The device according to claim 1, wherein the computer program in the electronic equipment executes in real time, illustrating instantaneously where products, places or items looked for by the user are situated.

3. The device according to claim 1, wherein the computer program displays promotions that use audiovisual resources, as a way to call the attention of customers

and visitors of a place where the electronic equipment containing the program is installed.

4. The device according to claim 1, wherein the computer program is freely available for consultation in a world-wide network of computers.

5. The device according to claim 1, wherein the computer program is disposed on a CD or another media for free distribution to customers.

6. A device configured to generate and display a three-dimensional simulation path from a first point to a second point within a place of interest selected by a user, the device comprising:

a monitor having a display screen;

a device for controlling movement of an icon in the display screen; and

a computer readable medium including computer executable instructions,

wherein the instructions, when executed, implement a method for generating and displaying the three-dimensional simulation path from the first point to the second point within the place of interest selected by the user, the method comprising:

selecting the place of interest from a search menu in the display screen;

identifying the first and second points within the place of interest;

generating the three-dimensional simulation path from the first point to the second point; and

displaying the three-dimensional simulation path on the display screen with an

object in movement.

7. The device according to claim 6, wherein the displaying further comprises displaying in real time, illustrating instantaneously where products, places or items looked for by the user are located.

8. The device according to claim 6, wherein the three-dimensional simulation path is a shortest and best route from the first point to the second point.

9. The device according to claim 8, wherein the displaying further comprises displaying notes about the shortest and best route.

10. The device according to claim 6, wherein the displaying further comprises displaying promotions that use audiovisual resources to call the attention of customers and visitors of a place where the device is located.

11. The device according to claim 6, wherein the computer executable instructions are available in a world-wide network of computers.

12. The device according to claim 6, wherein the computer executable instructions are disposed on a CD or another media for distribution.

13. The device according to claim 6, where the place of interest is selected

from the group comprising departments, stores, items in exposition, numbered seats and strategic points of great shopping centers, museums, big stores, supermarkets, companies, houses of entertainment, theaters, fairs, and events.

X. RELATED PROCEEDING APPENDIX

Not applicable.